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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                                |   |                           |
|--------------------------------|---|---------------------------|
| In re Patent Application of :  | ) | Attorney No. 47004.000062 |
|                                | ) |                           |
| Christopher R. LEFEBVRE et al. | ) | Group Art Unit: 3622      |
|                                | ) |                           |
| Application No.: 09/688,694    | ) | Examiner: John L. Young   |
|                                | ) |                           |
| Filed: October 17, 2000        | ) | Confirmation No.: 2049    |
|                                | ) |                           |
| For: METHOD AND SYSTEM FOR     | ) | Customer No. 2197         |
| RETAINING CUSTOMER             | ) |                           |
| LOYALTY                        | ) |                           |

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### SUBMISSION OF APPEAL BRIEF

Sir:

In response to the Non-Final Office Action mailed April 30, 2004, Appellants hereby submit an Appeal Brief, in triplicate, in connection with the above-captioned patent application in compliance with 37 C.F.R. § 1.192 (c), along with the requisite filing fee. A Notice of Appeal is being filed concurrently herewith.

Respectfully submitted,

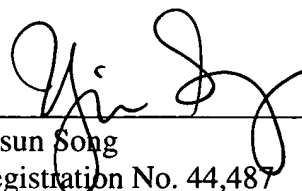
HUNTON & WILLIAMS LLP

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Dated: July 30, 2004



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|                                      | ) |                                  |
| Christopher R. LEFEBVRE <i>et al</i> | ) | Confirmation No. 2049            |
|                                      | ) |                                  |
| Serial No.: 09/688,694               | ) | TC/A.U.: 3622                    |
|                                      | ) | Examiner: John L. Young          |
| Filed: October 17, 2000              | ) |                                  |
|                                      | ) | Customer No. 21967               |
| For: METHOD AND SYSTEM FOR           | ) |                                  |
| RETAINING CUSTOMER                   | ) |                                  |
| LOYALTY                              | ) |                                  |

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**APPEAL BRIEF**

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**APPEAL BRIEF**

Appellants' Appeal Brief in connection with the above-captioned patent application is hereby submitted in triplicate. A check for the requisite fee in accordance with 37 C.F.R. § 1.17(c) is enclosed. A Notice of Appeal is being filed concurrently herewith. It is respectfully submitted that this Appeal Brief is timely filed. Each item required by 37 C.F.R. § 1.192 is set forth below. Appellants believe that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

In response to the Office Action dated April 30, 2004, rejecting pending claims 19-38, Appellants respectfully request that the Board of Patent Appeals and Interferences reconsider and withdraw the rejection of record, and allow the pending claims, which are attached hereto as Appendix A.

**I. REAL PARTY IN INTEREST**

The real party in interest is First USA Bank, the assignee of the above-referenced application.

**II. RELATED APPEALS AND INTERFERENCES**

To the best of Appellants' knowledge, there are no related Appeals or Interferences.

**III. STATUS OF CLAIMS**

Claims 19-38 are pending in the application. The rejections of each of claims 19-38 are appealed.

**IV. STATUS OF AMENDMENTS**

No amendments to the claims have been filed subsequent to the rejection dated April 30, 2004.

**V. SUMMARY OF INVENTION**

According to one embodiment of the present invention, a system and method provide incentives to customers where the incentives for retaining customer loyalty are tailored to the customer's needs and expectations while achieving profitability to the provider. (page 6, lines 12-16). An embodiment of the present invention determines a set of incentives based on call type, customer segmentation, as well as profitability factors. Upon receiving a request for termination or other request, the customer may be routed to an appropriate person, department, or group where the customer's account data may be identified and retrieved (page 8, line 21-page 9, line 1). The call type may be identified where the call type describes the caller's present situation (page 11, lines 9-18). Taking into consideration customer payment history and/or other

past behavior, the customer may be categorized as a customer segment (page 11, lines 19-page 12, line 4). Based on the call type, customer segment and profitability factors, a set of tailored incentives may be determined and offered to the customer to promote customer loyalty and retention (page 13, lines 4-14). If the customer does not accept the incentive, other sales opportunities may be offered to the customer in an effort to retain customer loyalty (page 9, line 7-10).

## **VI. ISSUES**

The issues on appeal are as follows.

A. Whether claims 19-38 are unpatentable under 35 U.S.C. § 103(a) by U.S. Patent No. 6,611,811 to Deaton *et al* ("Deaton *et al*").

## **VII. GROUPING OF CLAIMS**

None of the claims stand or fall together. The reasons why each claim is separately patentable are presented in the Arguments section below.

## **VIII. ARGUMENTS**

The rejections against the pending claims under consideration in the above-captioned patent application should be reversed for at least the reasons set forth below.

### **A. Brief Description of the Art Applied to the Claims**

U.S. Patent No. 6,611,811 to Deaton *et al*

Deaton *et al* appears to be directed to accumulating marginal discounts and applying an associated incentive upon exceeding a threshold. (see Abstract). Deaton *et al* enables a retail store owner to target only non-customers so that store owners do not waste mailing and marketing expenses on people in their targeted geographic area. (col. 57, lines 55-62). In other

words, with the invention of Deaton *et al*, the retailer would be able to use his marketing dollars to attempt to entice non-customers or infrequent customers to visit the store. (col. 57, lines 62-65).

Deaton *et al* alleges to determine and distribute an individualized, personalized, custom-tailored, inducement based on individualized consumption rate monitoring. (col. 101, lines 9-12). The history of products being purchased is stored and organized into arbitrary groups by manufacturer. (col. 100, lines 30-32). For example, the average consumption of a coffee product may be 4 ounces per week for an entire store or entire region. The system of Deaton *et al* stores the average consumption rate for the customer base as a whole so that the store can use that as a starting point for saying that a customer is at or below this consumption rate. (col. 100, lines 38-41). Deaton *et al* also purports to show that consumption rate is tracked per customer ID so that the store knows that the single woman living alone consumption rate is for clothes washing detergent vis-à-vis the family of seven. (col. 100, lines 47-51). The store or manufacturer of a product can thus structure an inducement based on the customer's consumption rate. (col. 100, lines 61-63).

The Deaton *et al* reference fails to obviate the combination of claim limitations, as recited by Appellants.

**B. Summary of Argument**

Claims 19-38 are improperly rejected under 35 U.S.C. § 103(a) by Deaton *et al* because the Office Action fails to set forth a *prima facie* case of obviousness. In particular, Deaton *et al* fails to show the claimed combinations of limitations.

**C. Independent Claims 19 and 29 are Patentable Over Deaton *et al***

The Office Action alleges that “the whole document” of Deaton *et al* makes obvious most of the claimed limitations. More specifically, the Office Action alleges that Deaton *et al* shows “retrieving account data associated with the customer in response to the request where the account data is displayed on a graphical user interface.” For this limitation, the Office Action relies upon FIG. 26 and col. 3, lines 51-55 (see pages 2-3 of Office Action mailed April 30, 2004). FIG. 26 is a flow diagram illustrating building of a marketing record based upon multiple accounts in a single household, which has nothing to do with retrieving account data in response to a request where account data is displayed on a graphical user interface. In addition, the Office Action fails to address the limitation of “receiving a request from a customer.” The Office Action alleges that the limitation of a graphical user interface is met by Deaton *et al*’s disclosure of computers in various figures. However, there is no discussion in connection with the figures or any other disclosure within Deaton *et al* that discusses the claim limitation of “retrieving account data associated with the customer in response to the request where the account data is displayed on the a graphical user interface.”

In addressing the limitation of “identifying the request as a request type, where the request type identifies the customer’s current situation,” the Office Action alleges that Deaton *et al* discloses “a customer verification status response.” The Examiner then summarily concludes



that “customer verification status response” is interpreted as showing “the customer’s current situation,” without any explanation or reasoning. The check transaction processing system 110 includes transaction terminals 120 located at point-of-sale, *e.g.*, grocery store checkout stands (col. 7, lines 16-17). Transaction terminals 120 are used to communicate information to transaction processor 112 for check transaction processing. A transaction terminal submits a request to the transaction processor, which processes the request and returns an appropriate response (col. 7, lines 21-25). In the case of a check verification, a transaction terminal is used to transmit a verification response - the customer’s check ID, the verification function code and the dollar amount (col. 7, lines 25-29). The transaction processor processes the request, updates the customer database to reflect that transaction and returns a customer verification status response (col. 7, lines 29-32). Based on the disclosure of Deaton *et al*, it is unclear as to how “customer verification status response” described in terms of check verification could be equated to “*identifying the request as a request type, where the request type identifies the customer’s current situation,*” as recited by Appellants. Not only does Deaton *et al* fail to provide “identifying the request as a request type” but the “customer verification status response” of Deaton *et al* fails to identify the customer’s current situation. Rather, the system of Deaton *et al* describes a completely different system for check transaction processing at a grocery store checkout stand.

In addressing the limitation of “identifying the customer as a customer segment, where the customer segment identifies the customer’s past behavior,” the Office Action relies upon FIG. 27 and column 3, lines 51-59, without any discussion (see page 3 of Office Action mailed April 30, 2004). FIG. 27 is a flow diagram illustrating a method of tracking infrequent shoppers

who are to receive a coupon. This disclosure fails to show segmenting customers for identifying past behavior. Rather, FIG. 27 tracks shoppers who are to receive coupons. Again, Deaton *et al* fails to show the claimed limitations.

The Office Action relies upon Deaton *et al* for disclosing marketing programs to induce customers to make additional purchases from a retail store (col. 57, lines 55-65). However, Deaton *et al* specifically directs the invention to target only non-customers so that store owners do not waste mailing and marketing expenses on people in their targeted geographic area who had been previous customers. (col. 57, lines 58-63). In other words, the retailer would be able to use marketing dollars to attempt to entice non-customers or infrequent customers to visit the store (col. 57, lines 63-65).

The Office Action relies upon Deaton *et al* for determining and distributing individualized, personalized, custom-tailored, inducement based on *individualized consumption rate monitoring* (col. 101, lines [1]7-13). As defined by Deaton *et al*, consumption rate analysis includes an analysis of the frequency and total dollars spent on an item (col. 90, lines 44-49). In other words, consumption rate is the rate at which an individual consumes or purchases a product from a merchant. Thus, Deaton *et al* monitors consumption rates of individuals and provides inducements based on the consumption rates (i.e., the rate at which a product is purchased). In contrast, the claimed inventions recite “*identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives.*” The invention of Deaton *et al* fails to consider request type (a request is not even received in Deaton *et al*), customer segment and profitability factors in generating an incentive in response to a request from a customer. The incentives of Deaton *et al*

and the incentives of the claimed invention are generated in a completely different manner. More specifically, the incentives of Deaton *et al* are based on a consumption rate where the incentives are targeted to non-customers. In contrast, the claimed incentives are based on request type, customer segment and profitability factors for retaining a customer in response to a request from the customer. The Office Action completely fails to show how the claimed inventions are met by Deaton *et al*.

The Office Action recognizes that Deaton *et al* fails to show at least “one of more profitability factors” and alleges that Deaton *et al* suggests the same by replying upon “col. 101, ll. 55-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-67; col. 112, ll. 1-20; the ABSTRACT; col. 3, ll. 51-59; col. 119; ll. 25-30;” and “the whole document.”<sup>1</sup> For at least these deficiencies, the Office Action alleges that it would have been obvious that the disclosure of Deaton *et al* would have been selected in accordance with “one or more profitability factors associated with a provider of the one or more incentives ...” because selection of such features would have provided means to “utilize marketing programs wherein users of a retail store’s services are targeted to attempt to induce the customers to make additional purchases from the retail store ...” Upon close examination of the highlighted excerpts as well as the whole document, there is nothing in Deaton *et al* to suggest one or more profitability factors, as recited by Appellants. In fact, profitability factors, as recited by Appellants, are not even discussed in Deaton *et al*. Further, the alleged teaching relied upon by

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<sup>1</sup> Deaton *et al* contains 88 pages of drawings and 192 columns of specification. The Examiner relies upon sporadic excerpts located all throughout Deaton *et al* to somehow forge together a rejection.

the Office Action has nothing to do with the admitted missing elements of Deaton *et al.* The basis for motivation is improper and the rejections should be withdrawn.

**D. The Claims Do Not Suffer From Undue Breadth**

The Office Action further alleges that the invention would have been obvious because the claims suffer from undue breadth (page 5 of Office Action dated April 30, 2004). Appellants respectfully disagree. Regardless of the Examiner's opinion on the scope of the claims, the Deaton *et al* reference nevertheless fails to show the claimed combinations, as recited by Appellants. Further, the Examiner has failed to explain or support this assertion with any development of reason but rather provides a mere conclusion that the claims suffer from undue breadth. In addition, the Office Action fails to explain how an allegation of undue breadth would render the claims obvious. In fact, an opinion of "undue breadth" has absolutely nothing to do with whether the claims are obvious over the cited reference. Appellants maintain that Deaton *et al* fails to show the claimed combination of limitations.

**E. The Modification of Deaton *et al* is Based Purely on Improper Hindsight**

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's sole justification for modifying Deaton *et al* has absolutely nothing to do with the deficiencies of Deaton *et al*. As admitted by the Office Action, Deaton *et al* fails to show at least "one or more profitability factors associated with a provider of the one or more incentives." To properly modify Deaton *et al* to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Deaton *et al*. Any such motivation is completely lacking.

Accordingly, the Office has failed to provide any proper motivation for modifying Deaton *et al*, so the proposed modification fails. Even if Deaton *et al* could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Applicants.

The mere fact that Deaton *et al* can be modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." The court also stated that "[i]t is impermissible within the framework of section 103 to pick and

choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art” (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

Therefore, Deaton *et al* fails to show, teach or make obvious the invention as claimed by Appellants. The Office Action has failed to provide proper motivation for modifying the Deaton *et al* reference. In addition, the Office Action has utterly failed to address each and every claim limitations, as recited by the independent claims and dependent claims. Even if the Deaton *et al* reference could be modified as suggested by the Office Action, the resulting combination would fail to disclose the combination of claimed limitations.

**F. Dependent claims 20-28 and 30-38 are Each Separately Patentable over Deaton *et al***

Claims 20-28 and 30-38 all depend ultimately from one of independent claims 19 and 29. As such, each of these dependent claims contain each of the features recited in the independent claims. For the reasons stated above, Deaton *et al* fails to disclose the claimed inventions and the rejections should be withdrawn. Additionally, these claims are separately patentable over Deaton *et al* for at least the reasons stated below.<sup>2</sup>

For the remaining dependent claims, the Office Action repeatedly relies upon “The ABSTRACT, FIG. 26, FIG. 27, FIG. 66, FIG. 48A, FIG. 2A, FIG. 49, FIG. 50, and FIG. 51, col. 3, l. 51-59; col. 7, ll. 25-35; col. 119, ll. 25-30; col. 101, ll. 17-13; col. 101, .. 55-67; col. 102, ll.

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<sup>2</sup> To date, the Examiner has failed to provide a basis of rejection for each and every claim limitation, as mandated by MPEP §§ 706.02(j) and 2143.03. The Examiner has continued to provide only a cursory rejection of all the limitations of the dependent claims and fails to set forth a basis for rejection of each dependent claim.

1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-67; col. 112, ll. 1-20; the ABSTRACT; col. 3, ll. 51-59; col. 119; ll. 25-30; col. 158, table 3-continued” and “the whole document”<sup>3</sup> Upon close examination of these highlighted section as well as the entire Deaton *et al* reference, it is clear that Deaton *et al* fails to show or make obvious the combination of claim limitations. The Examiner has failed to provide a basis of rejection for each and every claim limitation, as mandated by MPEP §§ 706.02(j) and 2143.03. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. The Examiner has clearly failed to reach the initial burden.

As discussed above, Deaton *et al* fails to show, teach or suggest *receiving a request from a customer*; retrieving account data associated with the customer in response to the request where the account data is displayed on a graphical user interface; *identifying the request as a request type, where the request type identifies the customer's current situation*; *identifying the customer as a customer segment, where the customer segment identifies the customer's past behavior*; *identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives*; and offering the customer at least one of the identified one or more incentives for retaining the customer *in response to the request*. System claim 29 recites similar limitations. The combination of claimed elements are simply not shown in Deaton *et al*. Of particular note is that the Examiner has repeatedly failed to point to an actual teaching in the reference, but rather relies on “the

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<sup>3</sup> As Deaton *et al* lacks any disclosure that meets the claimed combination of limitations, the Office Action has chosen to rely on essentially the entire disclosure of Deaton *et al*, without any effort to identify specific teachings within Deaton *et al* that would meet each and every claim limitation.

whole document.” It is clear that each limitation alone and in the claimed combinations, as recited by independent claims 19 and 29, are not shown in Deaton *et al.*

Claim 20 is separately patentable because Deaton *et al* fails to disclose *wherein the request is a request to terminate a relationship with the provider*. The Office Action’s rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 20. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. More specifically, the invention of Deaton *et al* appears to be directed to targeting incentives to non-customers, without a request from the non-customer. In other words, the incentives of Deaton *et al* are not provided to non-customers in response to a request to terminate a relationship because there is no relationship in the first place. Further, Deaton *et al* makes no mention or suggestion that a request to terminate a relationship with the provider is ever received in Deaton *et al*.

Claim 21 is separately patentable because Deaton *et al* fails to disclose *wherein the one or more incentives comprises a product offered by a financial institution*. The Office Action’s rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 21. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. The disclosure of Deaton *et al* discusses grocery store items. There is no mention or discussion of a product offered by a financial institution.

Claim 22 is separately patentable because Deaton *et al* fails to disclose *wherein the step of identifying the customer as a customer segment, further comprises the step of: assigning a value to the customer based on at least one of customer payment history, customer payment*



*habit, customer behavior data and credit bureau score.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 22. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose identifying the customer as a customer segment, Deaton *et al* further fails to disclose assigning a value the customer, as recited in claim 22.

Claim 23 is separately patentable because Deaton *et al* fails to disclose *wherein the step of identifying the customer as a customer segment, further comprises the step of: considering information related to at least one of customer delinquency data and customer attrition data.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 23. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose identifying the customer as a customer segment, Deaton *et al* further fails to disclose consideration of customer delinquency data and/or customer attrition data.

Claim 24 is separately patentable because Deaton *et al* fails to disclose *the step of: offering the customer another one of the identified one or more incentives for retaining the customer in response to the request.* The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 24. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature.

Claim 25 is separately patentable because Deaton *et al* fails to disclose *wherein the step of identifying one or more incentives further comprises the step of applying one or more restrictions on the one or more incentives based on the one or more profitability factors*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 25. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose the claimed profitability factors, Deaton *et al* further fails to provide any disclosure directed to applying restrictions based on the profitability factors.

Claim 26 is separately patentable because Deaton *et al* fails to disclose *wherein the request comprises one or more of a telephone call and Internet communication*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 26. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As discussed above, the claimed request is not received in the embodiments of Deaton *et al*.

Claim 27 is separately patentable because Deaton *et al* fails to disclose *wherein the one or more profitability factors comprise one or more of customer payment delinquency and customer ability to pay*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 27. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose the claimed profitability factors, Deaton *et al* further fails to provide any disclosure directed to customer payment delinquency and/or

customer ability to pay. The disclosure of Deaton *et al* clearly fails to disclose these additional features.

Claim 28 is separately patentable because Deaton *et al* fails to disclose *wherein the step of identifying the request further comprising the step of identifying a product associated with the customer, wherein the one or more incentives comprises an adjustment to the product*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 19. The Deaton *et al* reference fails to show each and every limitation of claim 28. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose identifying the request, Deaton *et al* further fails to provide any disclosure directed to identifying a product wherein the incentive comprises an adjustment to the product.

Claim 30 is separately patentable because Deaton *et al* fails to disclose *wherein the request is a request to terminate a relationship with the provider*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 30. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. More specifically, the invention of Deaton *et al* appears to be directed to targeting incentives to non-customers, without a request from the non-customer. In other words, the incentives of Deaton *et al* are not provided to non-customers in response to a request to terminate a relationship because there is no relationship in the first place. Further, Deaton *et al* makes no mention or suggestion that a request to terminate a relationship with the provider is ever received in Deaton *et al*.

Claim 31 is separately patentable because Deaton *et al* fails to disclose *wherein the one or more incentives comprises a product offered by a financial institution*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 31. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. The disclosure of Deaton *et al* discusses grocery store items. There is no mention or discussion of a product offered by a financial institution.

Claim 32 is separately patentable because Deaton *et al* fails to disclose *wherein the customer is assigned a value based on at least one of customer payment history, customer payment habit, customer behavior data and credit bureau score*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 32. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose identifying the customer as a customer segment, Deaton *et al* further fails to disclose assigning a value the customer, as recited in claim 32.

Claim 33 is separately patentable because Deaton *et al* fails to disclose *wherein the customer segmentation module considers information related to at least one of customer delinquency data and customer attrition data*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 33. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose

identifying the customer as a customer segment, Deaton *et al* further fails to disclose consideration of customer delinquency data and/or customer attrition data.

Claim 34 is separately patentable because Deaton *et al* fails to disclose *wherein the customer is offered another one of the identified one or more incentives for retaining the customer in response to the request*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 34. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature.

Claim 35 is separately patentable because Deaton *et al* fails to disclose *wherein one or more restrictions is applied on the one or more incentives based on the one or more profitability factors*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 35. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose the claimed profitability factors, Deaton *et al* further fails to provide any disclosure directed to applying restrictions based on the profitability factors.

Claim 36 is separately patentable because Deaton *et al* fails to disclose *wherein the request comprises one or more of a telephone call and Internet communication*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 36. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As discussed above, the claimed request is not received in the embodiments of Deaton *et al*.

Claim 37 is separately patentable because Deaton *et al* fails to disclose *wherein the one or more profitability factors comprise one or more of customer payment delinquency and customer ability to pay*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 37. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose the claimed profitability factors, Deaton *et al* further fails to provide any disclosure directed to customer payment delinquency and/or customer ability to pay. The disclosure of Deaton *et al* clearly fails to disclose these additional features.

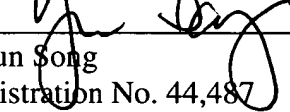
Claim 38 is separately patentable because Deaton *et al* fails to disclose *wherein the request module further identifies a product associated with the customer, wherein the one or more incentives comprises an adjustment to the product*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 29. The Deaton *et al* reference fails to show each and every limitation of claim 38. In addition, there is no teaching or motivation to modify Deaton *et al* to include this feature. As Deaton *et al* fails to disclose identifying the request, Deaton *et al* further fails to provide any disclosure directed to identifying a product wherein the incentive comprises an adjustment to the product.

**IX. CONCLUSION**

In view of the foregoing, Appellants respectfully request that the Board reverse the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

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## **APPENDIX A - PENDING CLAIMS**

### **CLAIMS**

Claims 1-18 (canceled)

Claim 19 (Previously Presented): A computer implemented method for providing one or more tailored incentives to a customer in response to a customer request, the computer implemented method comprising the steps of:

receiving a request from a customer;

retrieving account data associated with the customer in response to the request where the account data is displayed on a graphical user interface;

identifying the request as a request type, where the request type identifies the customer's current situation;

identifying the customer as a customer segment, where the customer segment identifies the customer's past behavior;

identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives; and

offering the customer at least one of the identified one or more incentives for retaining the customer in response to the request.

Claim 20 (Previously Presented): The method of claim 19, wherein the request is a request to terminate a relationship with the provider.

Claim 21 (Previously Presented): The method of claim 19, wherein the one or more incentives comprises a product offered by a financial institution.



Claim 22 (Previously Presented): The method of claim 19, wherein the step of identifying the customer as a customer segment, further comprises the step of:

assigning a value to the customer based on at least one of customer payment history, customer payment habit, customer behavior data and credit bureau score.

Claim 23 (Previously Presented): The method of claim 19, wherein the step of identifying the customer as a customer segment, further comprises the step of:

considering information related to at least one of customer delinquency data and customer attrition data.

Claim 24 (Previously Presented): The method of claim 19, further comprising the step of:

offering the customer another one of the identified one or more incentives for retaining the customer in response to the request.

Claim 25 (Previously Presented): The method of claim 19, wherein the step of identifying one or more incentives further comprises the step of:

applying one or more restrictions on the one or more incentives based on the one or more profitability factors.

Claim 26 (Previously Presented): The method of claim 19, wherein the request comprises one or more of a telephone call and Internet communication.

Claim 27 (Previously Presented): The method of claim 19, wherein the one or more profitability factors comprise one or more of customer payment delinquency and customer ability to pay.

Claim 28 (Previously Presented): The method of claim 19, wherein the step of identifying the request further comprising the step of:

identifying a product associated with the customer, wherein the one or more incentives comprises an adjustment to the product.

Claim 29 (Previously Presented): A computer implemented system for providing one or more tailored incentives to a customer in response to a customer request, the computer implemented system comprising:

a module for receiving a request from a customer;

a graphical user interface that displays account data associated with the customer;

a type module for identifying the request as a request type, where the request type identifies the customer's current situation;

a customer segmentation module for identifying the customer as a customer segment, where the customer segment identifies the customer's past behavior; and

an incentive module for identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives and wherein the customer is offered at least one of the identified one or more incentives for retaining the customer in response to the request.

Claim 30 (Previously Presented): The system of claim 29, wherein the request is a request to terminate a relationship with the provider.

Claim 31 (Previously Presented): The system of claim 29, wherein the one or more incentives comprises a product offered by a financial institution.

Claim 32 (Previously Presented): The system of claim 29, wherein the customer is assigned a value based on at least one of customer payment history, customer payment habit, customer behavior data and credit bureau score.

Claim 33 (Previously Presented): The system of claim 29, wherein the customer segmentation module considers information related to at least one of customer delinquency data and customer attrition data.

Claim 34 (Previously Presented): The system of claim 29, wherein the customer is offered another one of the identified one or more incentives for retaining the customer in response to the request.

Claim 35 (Previously Presented): The system of claim 29, wherein one or more restrictions is applied on the one or more incentives based on the one or more profitability factors.

Claim 36 (Previously Presented): The system of claim 29, wherein the request comprises one or more of a telephone call and Internet communication.

Claim 37 (Previously Presented): The system of claim 29, wherein the one or more profitability factors comprise one or more of customer payment delinquency and customer ability to pay.

Claim 38 (Previously Presented): The system of claim 29, wherein the request module further identifies a product associated with the customer, wherein the one or more incentives comprises an adjustment to the product.